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member and to conform at least the flexible strap member to a portion of the surface of the snowboarding boot, said flexible strap member including a pocket which is configured and arranged to movably receive a first end of the first strap member therein.

### **REMARKS**

#### **Allowable Subject Matter**

Applicants thank the Examiner for indicating that claims 36-50 are allowed. Applicants also note that claims 3, 4, 15, 16, 25, 29, 58, 59, 61, 66, 72, 73, 81, 91, 92, 99, and 100 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. However, Applicants have not rewritten these claims because Applicants believe that the claims upon which these claims depend are allowable.

#### **Rejection under 35 U.S.C. §112**

Claims 97-104 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, claim 97 is rejected because "the strap" lacks antecedent basis. Claim 97 has been amended by changing "strap" to "apparatus" in order to overcome this rejection. Accordingly, withdrawal of the rejection of claims 97-104 under 35 U.S.C. §112, second paragraph, is respectfully requested.

#### **Rejections Under 35 U.S.C. §103**

##### **I. Rejection Based on Hansen in View of Breuer**

Claims 1, 2, 5-14, 17-24, 26-28, 56, 57, 60, 62-65, 67-71, 74-80, 82-90, 93-98, and 101-104 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hansen (U.S. Patent No. 5,918,897) in view of Breuer (DE 44 16 024). This rejection is respectfully traversed.

##### **A. Motivation Not Proper**

##### **1. Hansen Teaches Away from the Combination**

Applicants respectfully submit that combination of Hansen and Breuer is improper because Hansen teaches away from the combination. MPEP 2144.05 states "A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches

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away from the claimed invention." Hansen emphasizes that his invention advantageously eliminates buckles such as the one described by Breuer. Specifically, in Hansen's binding, a "complicated threading of straps or toothed belts into locking buckles is unnecessary." (column 2, lines 58-60) Thus Hansen specifically highlights the fact that his binding does not contain toothed belts and locking buckles. Therefore, applicants respectfully submit that Hansen explicitly teaches away from combining the toothed belt/locking buckle of Breuer with the binding of Hansen.

2. Combination Would be Unsatisfactory for its Intended Purpose

Applicants also submit that the proposed combination is improper because the combination would be unsatisfactory for its intended purpose. According to MPEP 2143.01, "if [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Hansen specifically states that one advantage of his binding is that it is continuously adjustable. He states, "Both adjustments are thus possible continuously rather than step-by-step." (column 4, lines 66-67) In contrast, Breuer teaches using a locking buckle with a toothed strap. The toothed strap catches the locking buckle at discrete locations in order to retain the strap at a desired position. Thus, combining Hansen with Breuer would necessarily result in "step-by-step" adjustments, instead of the continuous adjustability Hansen promoted.

Therefore, Applicants respectfully submit that a *prima facie* case has not been presented because there is no motivation to combine Hansen with Breuer. Specifically, Hansen teaches away from the proposed combination and the combination would result in an invention which would be unsatisfactory for Hansen's intended purpose.

B. Resulting Combination Does Not Teach or Suggest All the Limitations of the Claim

Furthermore, even if one were motivated to combine the mechanism of Breuer with the binding of Hansen, the resulting combination does not teach all the limitations of the claims. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP 2143.03 Applicants respectfully submit that the combination of Breuer with Hansen neither teaches nor suggests all the limitations of the claims.

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The Office Action states that Hansen teaches all of the claimed elements except for ratcheting buckle elements to provide adjustability when the boot is in the binding. Thus, Breuer is relied upon to teach elements that may be adjusted while the boot is in the binding. Applicants respectfully submit that the combination of Hansen and Breuer does not teach the claimed structure. Specifically, the independent claims require that the *engagement* strap and the *binding* strap be connected in a manner that permits adjusting the binding strap about the boot. As stated in the Office Action, elements 5, 10 of Hansen constitute the binding strap. Thus, elements 8, 9, 11 of Hansen must be the mounting strap because they are inserted into the pocket of the binding strap. Therefore, elements 27-30 of Hansen must be the engagement strap. As noted in the Office Action, the binding strap 5, 10 and engagement strap 27-30 of Hansen are connected at the base to each other by screw 13. However, screw 13 does not permit relative movement between the engagement strap and the binding strap in order to "adjust tightening of the binding strap about the boot when the boot is in the binding" as required by the claims. Instead, "adjusting" screw 13 results in disassembly of the binding.

Put differently, Hansen teaches adjustability between the wrong straps. The buckles 27, 28 in Hansen provide adjustability between the *binding strap* 5, 10 and the *mounting strap* 8, 9, 11. The strap 8, 9, 11 cannot be the engagement strap because it is the only strap that is inserted into the pocket of the binding strap 5, 10. In other words, the location of the pocket determines how each strap is defined: the strap containing a pocket is the binding strap, the strap inserted into the pocket is the mounting strap, and a third strap is the engagement strap. Because Hansen's binding contains a single pocket, Hansen's straps can only be defined as described above. Thus, in Hansen, the buckles 27, 28 provide adjustability between the *binding strap* 5, 10 and the *mounting strap* 8, 9, 11, *not* between the *binding strap* 5, 10 and the *engagement strap* 27-30 as required by the claims.

Accordingly, withdrawal of this rejection is respectfully requested.

## II. Rejection Based on Hansen in View of Breuer and Andre

Claims 23, 24, 26, 27, 28, 56, 57, 60, 62-65, 67-71, 74-80, 82-84, and 87 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hansen (U.S. Patent No. 5,918,897) in view of Breuer (DE 44 16 024) and Andre (U.S. patent 2,531,763). Specifically, Andre is relied upon

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to teach a mounting system which includes a plurality of apertures and a mating fastener. This rejection is also respectfully traversed.

The combination of Hansen, Breuer, and Andre is improper because it frustrates the purpose of Hansen. Hansen states that other bindings disadvantageously must be adjusted after every use. (column 1, lines 42-45) Additionally, the only stated object of Hansen's invention is to "improve the snowboard binding ... such that getting into and out of it is considerably simplified and that a *predefined* closure position of all elements of the binding is reassumed with very little effort after every closure of the binding." (column 1, lines 53-57, emphasis added) Thus Hansen emphasized the goal of providing a binding with a preset closure position.

Andre teaches a hook and aperture system, where a user places his foot into the boot and secures a hook into one of several predefined holes. The continuous tension between the hook and hole, provided by the user's leg, retains the hook in the desired hole. If a hook were placed into one of the holes in Andre without providing tension between the hook and hole, the hook would fall out of the desired hole. Likewise, if one were to substitute the hook system taught by Andre into the binding of Hansen, the binding would not be able to provide a preset closure position. When there is no boot in the binding, there would be no tension between the hook and the hole, and thus the hook would tend to disengage from the desired hole. Therefore, a user would have to readjust this portion of the binding after each insertion, thus frustrating one of Hansen's stated purposes.

Thus, because substituting the hook/aperture system of Andre for the closure system of Hansen would frustrate Hansen's purpose of providing a preset closure position, Applicants submit that a *prima facie* case of obviousness has not been presented. Accordingly, withdrawal of this rejection is respectfully requested.

#### CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

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If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

*Carpenter et al., Applicants*

By:

Neil P. Ferraro, Reg. No. 39,188  
WOLF, GREENFIELD & SACKS, P.C.  
600 Atlantic Avenue  
Boston, Massachusetts 02210-2211  
Tel. No.: (617) 720-3500

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MARKED-UP CLAIMS

Claim 97 has been amended as follows:

97. (Amended) An apparatus for engaging a snowboarding boot, the [strap] apparatus being securable to a first strap member and further being releasably connectable to a second strap member, the [strap] apparatus comprising:

a flexible strap member configured and arranged to be connected to the second strap member to adjust the relative positions of the flexible strap member and the second strap member and to conform at least the flexible strap member to a portion of the surface of the snowboarding boot, said flexible strap member including a pocket which is configured and arranged to movably receive a first end of the first strap member therein.